

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 2, 10, 11, and 13 and the addition of new claims 28 and 29, claims 1, 3 to 9, 12, and 14 to 29 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for apparently considering the previously filed Information Disclosure Statements, PTO-1449 papers and cited references. Regarding the initialed copies of the PTO-1449 papers provided with the Office Action, it is noted that the "Other Documents" section of those PTO-1449 papers have not been initialed. As there is no apparent reason why the documents listed in the "Other Documents" section of those PTO-1449 papers might not have been considered, Applicant respectfully requests copies of those PTO-1449 papers with the "Other Documents" sections initialed so that the record is clear that these documents have been fully considered.

### **II. Objection to Claim 7**

Regarding the objection to claim 7, while this objection is not necessarily agreed with, to facilitate matters, claim 7 has been amended herein without prejudice to delete the phrase, "the at least one second axial section having a greater distance from the center axis of the tubular element than the first axial section," thereby rendering moot the present objection. Withdrawal of this objection is respectfully requested.

### **III. Rejection of Claims 1 to 4, 6 to 14, 16, 17, 19, 22, and 23 Under 35 U.S.C. § 112**

Claims 1 to 4, 6 to 14, 16, 17, 19, 22, and 23 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite.

Claims 2, 10, 11, and 13 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to these claims.

Regarding claim 4, the Examiner will note that claim 4 has been amended herein without prejudice to recite that the second axial section is configured so that the inner surface of the tension ring does not rest against the outer wall of the tubular element in the second axial section, thereby obviating this rejection with respect to claim 4.

Regarding the alleged lack of antecedent basis for “the tubular element,” while Applicant does not necessarily agree with this contention, to facilitate matters, claim 1 has been amended herein without prejudice to positively recite “a tubular element.”

Regarding the alleged lack of antecedent basis for “the body,” while Applicant does not necessarily agree with this contention, to facilitate matters, claim 1 has been amended herein without prejudice to recite that an arrangement includes a tubular element connectable to a body extending into the tubular element, which provides sufficient antecedent basis for “the body.”

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 1 to 27 Under 35 U.S.C. § 102(b)**

Claims 1 to 27 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,692,051 (“Stansbury et al.”). It is respectfully submitted that Stansbury et al. do not anticipate the present claims as amended herein for at least the following reasons.

As an initial matter, the Examiner will note that claims 2, 10, 11, and 13 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to these claims.

Furthermore, the Examiner will note that claim 1 has been amended herein without prejudice to recite that an arrangement includes a tubular element that is connectable to a body extending into the tubular element. The Office Action considers knob 32 to constitute a tubular element. However, claim 1 further recites that a tension ring is adapted to apply a clamp force to the tubular element so that the tubular element acts via an inner wall of the tubular element on a body extending into the tubular element to clamp the tubular element. There is no indication whatsoever by Stansbury et al. that cylinder 12, which the Office Action considers to constitute a tension ring, is adapted to apply a clamp force to the knob 32 so that the

knob 32 acts via an inner wall of the knob 32 on a body extending into the knob 32 to clamp the knob 32.

Notwithstanding the foregoing, claim 1 has been amended herein without prejudice to recite that the tension ring is adapted to embrace, by an inner surface, an outer wall at an end of the tubular element and that the tension ring is adapted to apply a clamp force to the tubular element so that the tubular element acts via an inner wall of the tubular element on a body extending into the tubular element to clamp the tubular element on the body. Support for these amendments may be found, for example, in Figures 1 and 2. There is absolutely no indication whatsoever by Stansbury et al. that cylinder 12 is adapted to embrace, by an inner surface, an outer wall at an end of the knob or that cylinder 12 is adapted to apply a clamp force to the knob 32 so that the knob 32 acts via an inner wall of the knob 32 on a body extending into the knob 32 to clamp the knob 32 onto a body.

Claim 1 has been further amended herein without prejudice to recite that the tension ring includes a first axial section and a second axial section contiguous in an axial direction to the first axial section. Support for this amendment may be found, for example, in original claim 4. Claim 1 recites that the tension ring is adapted to rest by only the first axial partial section of the inner surface against the outer wall of the tubular element and is adapted to exert a clamp action on the outer wall of the tubular element. Claim 1 has been also amended herein to recite that at the end, a wall of the tubular element on which the tension ring is to be positioned includes a smaller thickness than a contiguous axial region of the tubular element and that the first axial section is configured to face an end face of the end of the tubular element. Support for these amendments may be found, for example, in original claims 10, 11, and 13. Any review of Stansbury et al. makes plainly clear that these features are not in any manner disclosed, or even suggested, by Stansbury et al.

It is, of course, “well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office.” Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . .

claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Stansbury et al. do not disclose, or even suggest, all of the features included in claim 1. It is therefore respectfully submitted that Stansbury et al. do not anticipate claim 1.

As for claims 3 to 9, 12, and 14 to 26, which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that Stansbury et al. do not anticipate these dependent claims for at least the reasons more fully set forth above.

Regarding claim 27, since claim 27 includes features analogous to features included in claim 1, it is respectfully submitted that Stansbury et al. do not anticipate claim 27 for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **V. New Claims 28 and 29**

Claims 28 and 29 have been added herein. It is respectfully submitted that claims 28 and 29 add no new matter and are fully supported by the present application, including the Specification.

It is respectfully submitted that claim 28 is patentable over the reference relied upon for at least the reason that Stansbury et al. make no mention whatsoever of a tubular element including a hollow shaft of a rotary encoder or a body extending into the hollow shaft, the body including a drive shaft of a machine, as recited in claim 28.

Since claim 29 includes features analogous to features included in claim 1, it is respectfully submitted that claim 29 is patentable over the reference relied upon for at least the reasons more fully set forth above in support of the patentability of claim 1.

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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By: /Clifford A. Ulrich/  
Clifford A. Ulrich  
Reg. No. 42,194

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**